

USPTO Serial No. 10/796,840 (Docket No. CHRI-013)

REMARKS

Claims 1-4, 7-17 are pending in this Application, with Claims 1, 7, 8, 9 being amended and Claims 18, 19 being added. Applicant has amended the drawings in accordance with the Examiner's helpful suggestions. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-4, 7-17 and favorable consideration of Claims 18, 19 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Official Action

The Examiner objected to the drawings because of the placement of reference numerals. The Applicant has amended Figures 1 through 6 and has attached the same as Replacement Sheets.

Regarding the objection to the "*bed support members which detail the third and the fourth width*" not being shown in the drawings, the Applicant respectfully submits that the phrase "bed support members" is not used in any of the claims. The Applicant does state that the third width is measured by the "pair of support members" which are reference numerals 34 (see Figures 7 and 8 in particular). The Applicant further states that the fourth width is measured by the "inverted U-shaped base member" which is reference numeral 32 (see Figures 7 and 8). The Applicant respectfully submits that no amendment of the drawings is required to comply with 37 CFR 1.83(a).

The Applicant respectfully requests the drawing objections to be withdrawn.

Paragraph 2 of the Official Action

The Office Action rejected Claims 6-10 under 35 U.S.C. §112, second paragraph. The Applicant has amended dependent Claim 6 (now canceled and incorporated into independent Claim 1) to clarify what "support members" is comprised of. The Applicant respectfully requests withdrawal of this rejection.

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With respect to the question regarding Claim 10, the Applicant does not understand what is not understood or indefinite in this claim. Dependent Claim 10 claims "*wherein said first width is approximately 43 inches and wherein said second width of said base structure is approximately 60 inches*" which the Applicant has reviewed and respectfully submits is definite language. The Applicant respectfully requests withdrawal of this rejection.

Paragraph 3 of the Official Action

The Official Action rejected Claims 1-5, 11-17 under 35 U.S.C. §103(a) as being unpatentable over Hewitt (U.S. Patent No. 5,224,569) in view of Hewitt (U.S. Patent No. 6,612,775). The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

i. Burden on Examiner to Establish Prima Facie Case

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.¹ When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.² "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."³

"To establish a *prima facie* case of obviousness, three basic criteria must be met."⁴ First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**.

¹ *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

² *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

³ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

⁴ MPEP §706.02(j).

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Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.⁵

ii. Legal Requirements for Obviousness

"Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination."⁶ "An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art."⁷ "As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.**"⁸ Obviousness requires proof "that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed."⁹

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

⁵ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁶ *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.")); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) ("When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention."); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cri.1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

⁷ *Id.*

⁸ *Id.*

⁹ *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

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'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

iii Analysis

The Office Action admits that Hewitt ('569) does not disclose wherein the support bed has a first width that is at least 20 percent less than a second width of the base structure. The Office Action uses Hewitt ('775) to provide this missing subject matter. However, Figure 3 of the '775 patent clearly shows that the longitudinal rails (40/42) are not "at least 20 percent less than a second width of said base structure" as claimed in independent Claim 1.

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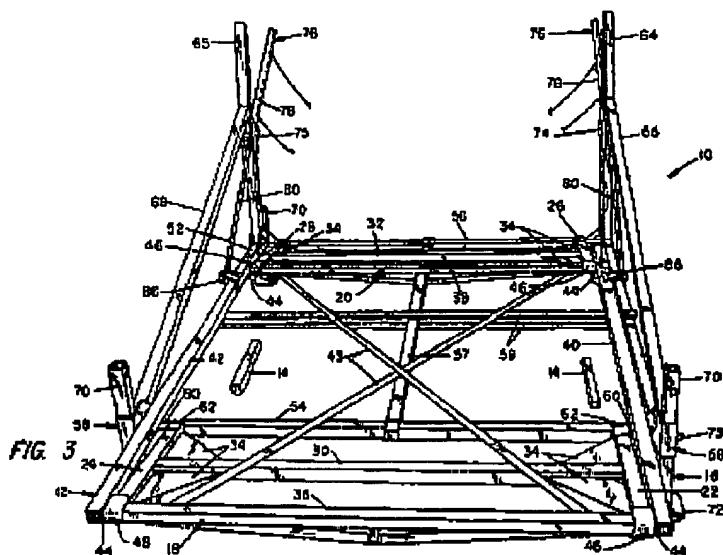


Figure 3 of Hewitt ('775)

There is no reason in the '775 patent for a narrower support bed in relation to the base since the '775 patent is not intended for nor is it capable of being utilized for pontoons. The '775 patent is intended to support watercraft "such as motorboats, sail boats, personal watercraft." (Column 1, Lines 15-16.)

With respect to dependent Claim 13 (also added to new independent Claims 18, 19), there is no suggestion of motivation with any of the Hewitt references for "*wherein said support bed includes a rear tapered portion that tapers inwardly for assisting in loading of a pontoon*". The reason for this is simply because Hewitt is not designed nor is it capable of receiving a pontoon which has a completely different hull structure compared to a regular watercraft. Tapering the support members of Hewitt inwardly would actually prevent the watercraft from entering the support members and thereby make the Hewitt references non-usuable.

Finally, the Applicant has amended independent Claim 1 to include the following features which is not discussed in the Office Action:

wherein said lifting jacks each are comprised of an inverted U-shaped base member and a pair of support members extending upwardly from said base structure, wherein

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a third width of said support members is at least 30 percent less than a fourth width of said inverted U-shaped base member;

Hence, there is **no suggestion or motivation**, either in the Hewitt references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there is **no reasonable expectation of success**. Finally, the Hewitt references when combined do **not teach or suggest all the claim limitations**.

For these reasons, among others, the combination of the Hewitt references cannot suggest the combination of features in applicant's Claims 1-4, 7-19, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-4, 7-19 allowed.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

In addition, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,



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5-30-06

Date

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